REMARKS

Reconsideration of this application as amended is respectfully requested.

In the Final Office Action, claims 1-5, 7-17, 19-29, 31-41 and 43-52 were pending and

rejected. In this response, claims 2-3, 7, 14-15, 19, 26-27, and 37-43 have been canceled

without prejudice. Claims 1, 8, 13, 20, 25, 32, and 44 have been amended to particularly

point out and distinctly claim, in full, clear, concise, and exact terms, the subject matter which

Applicant regards as his invention. No new matter has been added.

Claims 1-4, 7, 13-16, 19, 25-28, 31 and 44 are rejected under 35 U.S.C. 102(e) as

being anticipated by U.S. Patent No. 6,448,979 to Schena et al. ("Schena"). In view of the

foregoing amendment, it is respectfully submitted that the present invention as claimed

includes limitations that are not disclosed by Schena.

Specifically, for example, independent claim 1 recites as follows:

1. A method comprising:
 creating a multimedia annotation for a paper document, the multimedia
  annotation representing <u>at least one of an audio sound and a video clip</u>;
  and
 creating a first multimedia document by combining the paper document and <u>the</u>
  <u>multimedia annotation represented by a first bar code encoding the at</u>
  <u>least one of the audio sound and video clip,</u>
 wherein the first multimedia document is generated as a part of reproducing the
  paper document <u>via a document reproduction system</u>, and
 <u>wherein the first multimedia document, which when scanned, causes the</u>
  <u>printed multimedia annotation to be decoded, the at least one of the audio</u>
  <u>sound and video clip to be extracted from the multimedia annotation, and</u>
  <u>the at least one extracted audio sound and video clip can be played via a</u>
  <u>multimedia player.</u>

(Emphasis added)

Independent claim 1 requires encoding at least one of the audio sound and video clip

in a bar code which can be printed on a multimedia document, when the multimedia document

is generated by a document reproduction system such as a scanner or a copier by reproducing

a paper document. The multimedia document having the bar code encoding the at least one of the audio sound and video clip can be subsequently scanned and the bar code is decoded to extract the audio sound and/or video clip. The extracted audio sound and video clip can be played by a multimedia player. The multimedia document could be a physical paper document or an electronic document (see, e.g., claims 8 and/or 44, etc.) It is respectfully submitted that these limitations are absent from Schena.

Rather, instead of creating a multimedia document by combining a paper document with a multimedia annotation, Schena discusses extracting a machine readable code from an existing printed medium, where the machine readable code contains a URL to access a remote location to retrieve provider information (see, Abstract of Schena). There is no mention or suggestion within Schena of creating a multimedia document by combining a paper document with a multimedia annotation, particularly, as a part of reproducing the paper document via a document reproduction system, such as, for example, a copy machine.

In addition, Schena fails to disclose or suggest that the machine-readable code of the printed medium represents <u>at least one of an audio clip and a video clip</u> via a bar code that encodes the audio and/or video clips. That is, the audio sound and/or video clip are encoded within the bar code on within the document. Rather, the machine-readable code of Schena contains a URL link to a remote location from which the provider information can be downloaded (see, col. 2, lines 8-25 of Schena). Therefore, the machine-readable code of Schena does not encode at least one of an audio sound and a video clip. Further, there is no disclosure or suggestion within Schena that the machine-readable code is in a form of a bar code.

In order to anticipate a claim, each and every limitations of the claim have to be disclosed by the reference. It is respectfully submitted that Schena fails to disclose each and

every limitations set forth above. Therefore, for the reasons discussed above, it is respectfully submitted that independent claim 1 as amended is not anticipated by Schena.

Similarly, independent claims 13 and 25 include limitations similar to those recited in claim 1. Thus, for the reasons similar to those discussed above, independent claims 13 and 25 are not anticipated by Schena.

Given that the rest of the claims depend from one of the above independent claims, at least for the reasons similar to those discussed above, it is respectfully submitted that the rest of the claims are not anticipated by Schena.

Claims 5, 17 and 29 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Schena in view of U.S. Patent No. 5,337,362 to Gormish et al. ("Gormish"). Claims 8-10, 20-22, 32-34, 37-41 and 45-52 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Schena in view of "The Origami Project: Paper Interfaces to the World-Wide Web" to Peter Robinson ("Robinson"). Claims 11, 23, 35 and 43 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Schena in view of Robinson, as applied to claims 8, 20, 32 and 38 above, and further in view of U.S. Patent No. 6, 208, 436 to Cunningham ("Cunningham"). Claims 12, 24 and 36 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Schena in view of Robinson as applied to claims 11, 23 and 35 above, and further in view of U.S. Patent No. 5,880,740 to Halliday, et al. ("Halliday").

The above-identified claims depend from one of the above independent claims. For the reasons similar to those discussed above, it is respectfully submitted that Gormish, Robinson, Cunningham, and Halliday, individually or in combination, also fails to disclose the limitations set forth above.

Specifically, for example, Robinson is related to a digital desktop that captures a user's interaction and performs certain operations in response to the user's interaction (see, e.g., page

1 of Robinson). Specifically, "[a] Web page can be printed on paper and then placed on the digital desk and animated: when a link is selected with a pen, the corresponding link in the original HTML document is followed and the resulting page is projected onto the desk" (see, e.g., page 2 of Robinson, emphasis added). Thus, Robinson discloses following a link to retrieve another Web page in response to a user's action (e.g., highlight or point to the link using a pen), which is not the same as combining a multimedia annotation with a paper document to generate a multimedia document having the encoded annotation, which when scanned, the annotation is decoded and an audio sound and/or video clip are extracted from the annotation.

It is respectfully submitted that none of the cited references, individually or in combination, discloses or suggests the limitations set forth above. Therefore, these claims are patentable over the cited references. Withdrawal of the rejection is respectfully requested.
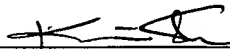
In view of the foregoing, Applicant respectfully submits the present application is now in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300.

Please charge Deposit Account No. 02-2666 for any shortage of fees in connection with this response.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: _____May 1, 2006_____   _____

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